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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,739	03/12/2001	Eric R. Sklar	440452	9934

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LEYDIG VOIT & MAYER, LTD  
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EXAMINER	
HANDY, DWAYNE K	
ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,739

Applicant(s)

SKLAR ET AL.

Examiner

Dwayne K Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

On pages 11 and 12, applicant has referred to the alignment pins as element #76 when describing the Figures. It appears this is merely an oversight as applicant has properly identified the pins as element #74 on page 12, line 3. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Aysta et al. (5,264,184). Aysta teaches a device and method for filtering liquid samples. The embodiment of the device most relevant to the instant claims is shown in Figure 5 and described in column 8, lines 28-67. The device has a bottom housing (44) that is open on the top and contains a connecting piece (48) for a suction hose (49) which allows for the application of vacuum. The bottom part also accommodates a rack (50) into which a plurality of collection containers are disposed. A block (58) with wells (58) is disposed over the opening of the bottom housing such that the position of wells

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(58) corresponds to the collection containers below. Aysta cites methods of using in claims 21-22 and in column 6, lines 11-17 and in column 7 lines 15-22. Method steps include loading the wells and drawing them simultaneously into the sample containers below.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aysta et al. (5,264,184) in view of Ruediger et al. (6,267,930). Aysta, as described above in paragraph 3, teaches every element of claim 3 except for the key mechanism for aligning the two elements of the device comprised of a post with a first and second ends. Ruediger teaches a modular synthesis device comprised of stackable

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components which align to form a reaction block. As shown in Figure 3 and described in column 8, line 61 – column 9, line 15, the lower level valve block "C" contains 4 standoffs which are used to align the upper blocks/plates that are stacked onto the valve block. The upper plates/blocks contain apertures through which the standoffs are inserted. It would have been obvious to one of ordinary skill in the art to add the standoff elements of Ruediger to the device of Aysta. The addition of the standoff elements would allow for the alignment of the upper portion of Aysta's device with the vacuum block when assembling the two parts.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aysta et al. (5,264,184) in view of Cody et al. (5,612,002). Aysta, as described above in paragraph 3, teaches every element of claim 3 except for directing the samples to a liquid chromatograph. Cody teaches a synthesis device which utilizes filtration through the placement of filters (14) on the end of reaction wells (16). Cody then analyzes the filtered reaction mixtures with HPLC and TLC (column 13, lines 10-39). It would have been obvious to combine the liquid chromatography analysis step of Cody with the filtration method of Aysta. One would add the analysis by liquid chromatography to analyze the filtered materials.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wertz et al. (4,777,021), Matkovich et al. (4,797,259), Root et al.

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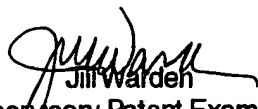
(4,948,564), Fernwood et al. (5,141,719), Clark et al. (5,223,133), Bankier et al. (5,846,493), and Stanchfield et al. (6,054,100) also teach array filtration devices. Smith (6,117,394), DeWitt (6,183,645), and Colpan (6,277,648) teach filtration into single collection tubes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

Dkh  
September 29, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700